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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,851	07/15/2003	Michael K. Barnoski	1125/204	2543
26588	7590	10/11/2006	EXAMINER	
LIU & LIU 444 S. FLOWER STREET SUITE 1750 LOS ANGELES, CA 90071			LE, HUNG CHARLIE	
			ART UNIT	PAPER NUMBER
			3663	

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,851

Applicant(s)

BARNOSKI ET AL.

Examiner

Hung C. Le

Art Unit

3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 28 is/are pending in the application.
- 4a) Of the above claim(s) 6, 13, 25 - 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 5, 7 - 12, 14 - 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date Various.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I (Claims 1 – 24), Species A (Fig. 3a) and sub-species a (Fig. 8b) in the reply filed on 07/18/2006 is acknowledged. The traversal is on the ground(s) that:

The restriction requirements, set forth in the Office Action dated 06/16/2006, are improper and the species are related.

These reasons are not found persuasive because species belonging to one genus are related but it does not follow that they are not patentably distinct. The only proper traverse to an election of species requirement is to state that the species are not patentable distinct. If the applicant(s) wish to do so, applicant(s) should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U. S. C. 103(a) of the other invention.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 25 – 28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group, there being no allowable generic

Art Unit: 3663

or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 06/16/2006.

3. Claims 6 & 13 are not directed to the elected species (A,a). Claim 6 is directed to the non-elected species B (Fig. 4) and claim 13 is directed to the non-elected sub-species a (Fig. 8a). Therefore, claims 6 & 13 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected species.

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 & 11 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "...with the punch in a manner whereby..." is a relative term. It is not known what all is meant and encompasses by the term "manner" as it is not clear how the process works.

7. Claim 20 recites the limitation "the actuator plate" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 – 5, 7- 12, 18 - 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Schroth et al. (US 6,311,597 B1).

With respect to claim 1: Schroth (Abstract, Figs. 1 – 18, Claims) discloses: An apparatus for producing parts, comprising:

a tool comprising complementary punch and die (100 & 200); a die holder (Fig. 2) for supporting the die; a punch guide having a shaft for guiding the punch in relation to the die (Fig. 2), wherein the shaft is sized and shaped to receive the punch in slidable contact; and an interface (Fig. 2) capable of mechanically interfacing force from a press with the punch in a manner whereby the punch is structurally decoupled from the press (Fig. 2).

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

With respect to claim 2: Schroth (Abstract, Figs. 1 – 18, Claims) further discloses: wherein the die holder includes a pocket for nesting the mating surface of the die in confronting orientation with the mating surface of the punch (Fig. 2).

With respect to claim 3: Schroth (Abstract, Figs. 1 – 18, Claims) further discloses: a backup plate attachable to the die holder over the pocket for securing the die within the pocket (See Fig. 2).

With respect to claim 4: Schroth (Abstract, Figs. 1 – 18, Claims) further discloses: a spacer disposed between the die holder and the punch guide, such that a workspace is defined between the die holder and punch guide where the punch engages with

the die to produce the part (See Fig. 2).

With respect to claim 5: Schroth (Abstract, Figs. 1 – 18, Claims) further discloses: wherein the punch guide, the die holder and the spacer are provided as a unitary structure (See Fig. 2).

With respect to claim 7: Schroth (Abstract, Figs. 1 – 18, Claims) further discloses: a stop disposed between the press and the punch, along a stroke path of the press, for limiting the translation of the punch through the shaft (Fig. 2).

With respect to claim 8: Schroth (Abstract, Figs. 1 – 18, Claims) further discloses: a stop disposed along a stroke path of the punch, for limiting the translation of the punch through the shaft (Fig. 2).

With respect to claim 9: Schroth (Abstract, Figs. 1 – 18, Claims) further discloses: wherein the punch includes a catch adapted to engage the stop, such that when the catch engages the stop, the stop limits further translation of the punch towards the die (Fig. 2).

With respect to claim 10: Schroth (Abstract, Figs. 1 – 18, Claims) further discloses: biasing means coupled to the punch, the biasing means being biased when the punch translates towards the die under the force of the press, the biasing means

being capable of moving the punch away from the die when the force is removed (Fig. 2).

With respect to claim 11: Schroth (Abstract, Figs. 1 – 18, Claims) discloses: A system for producing parts, comprising: a press having a press bed and a press ram; at least one stamping station supported on the press bed for supporting complementary punch and die, each stamping station comprising: a die holder for supporting the die; a punch guide having a shaft for guiding the punch relative to the die, wherein the shaft is sized and shaped to receive the punch in slidable contact; and an interface capable of mechanically coupling force from the press ram with the punch in a manner whereby the punch is structurally decoupled from the press ram.

With respect to claim 12: Schroth (Abstract, Figs. 1 – 18, Claims) further discloses: wherein the interface comprises a ball attached to the punch and a socket attached to the press ram, wherein when ball engages the socket, the press ram is capable of coupling the force from the press ram to the punch, but being structurally decoupled from the punch (Fig. 2).

With respect to claim 18: Schroth (Abstract, Figs. 1 – 18, Claims) further discloses: a stop block located between the punch and the die holder, the stop block being capable of inhibiting translation of the punch towards the die holder when the punch holder contacts the stop block.

With respect to claim 19: Schroth (Abstract, Figs. 1 – 18, Claims) further discloses: a spacer disposed between the die holder and the stop block for positioning the stop block relative to the die holder.

With respect to claim 20: Schroth (Abstract, Figs. 1 – 18, Claims) further discloses: wherein the interface further comprises a ball attached to the actuator plate and a socket attached to the press ram, wherein when ball engages the socket, the press ram is capable of coupling the force from the press ram to the actuator plate, but being structurally decoupled from the actuator plate (Fig. 2).

10. The statements of intended use or field of use, e.g., “for producing, capable of, for limiting, being capable of, supplying, for controlling, adapted to, etc...” clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte

Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Allowable Subject Matter

11. Claims 14 – 17, 21 – 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung C. Le whose telephone number is 571-272-8757. The examiner can normally be reached on M-F: 07:30am - 05:00 pm.
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is

Art Unit: 3663

571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HCL
09/28/06


JACK KEITH
SUPERVISORY PATENT EXAMINER